

Attorney Docket No. 0114089.00121US2
Date of Electronic Deposit: February 28, 2008

ATTACHMENT A

(EVIDENCE APPENDIX)

ATTACHMENT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	APRIL 13, 2006 FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,306	12/03/2003	Douglas B. Wilson	114089.120	5202
23483	7590	DOCKET DEPT. WILMER CUTLER PICKERING HALE and DORR LLP 60 STATE STREET BOSTON, MA 02109	EXAMINER	LUONG, VINH
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

*WILMER CUTLER PICKERING
HALE and DORR LLP DOCKETING*
 RE: 114089-121651
 Action Date: 6-30-06
 Action to be Taken: OAB/GE
 Docketed By: JMB On: 4-3-06

Office Action Summary	Application No.	Applicant(s)
	10/727,306	WILSON, DOUGLAS B.
	Examiner Vinh T. Luong	Art Unit 3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 1/30/06 & 2/8/06.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-23, 14/20, 25, 26, 28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-19, 24/14, 27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: Attachments 1-3.

Art Unit: 3682

1. The Amendment filed on January 30, 2006 and the Letter in Response to the Signature filed on February 8, 2006 have been entered.

2. Applicant's election of the species of Figs. 1, 3, and 4 in the reply filed on January 30, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

3. Claims 20-23, 24/20, 25, 26, and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 30, 2006.

4. The drawings are objected to because each part of the invention, such as, the angle in claim 14 should be designated by a referential numeral or character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities: each part of the invention, such as, the angle in claim 14 should be designated by a referential numeral or character. Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, the angle in claim 14. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 14-19, 24/14, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “rigid,” “semi-rigid,” “flexible,” or “non-deformable” in claims 14 and 27 is a relative term, which renders the claim indefinite. The term “rigid,” “semi-rigid,” “flexible,” or “non-deformable” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of Rockwell hardness of the material of the second section is required in order to be considered as being “rigid,” “semi-rigid,” “flexible,” or “non-deformable.” See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC N Ill 1969) (“Flexibility” and “rigidity” are relative terms, particularly since virtually any thing will flex if enough pressure is applied to it).

It is unclear whether:

- (a) the term that appears at least twice, such as, "a steering wheel" in claim 15/14 refers to the same or different things. See double inclusion in MPEP 2173.05(o); and
- (b) a confusing variety of terms, such as, "a peripheral portion of the steering wheel" and "a predetermined peripheral portion of the steering wheel" in claim 17/14 refers to the same or different things. See MPEP 608.01(o).

9. Claims 14-17, 19/17, 24/14, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Van Arsdel (US Patent No. 2,118,540).

Regarding claim 14, Van Arsdel teaches a fatigue relieving/preventing apparatus associated with a steering wheel 3 for controlling a vehicle, comprising:

a first section 4 (i.e., a horizontal section) that connects to a peripheral portion of the steering wheel 3; and

a rigid, semi-rigid or flexible, or non-deformable second section 2 that connects to, and extends from the first section 4 at the peripheral portion of the steering wheel 3, the second section 2 extends from the first section 4 outward at an angle (see angle α in Figs. 3 and 5 of Attachment 1) to a plane (Att. 1) across a front face of the steering wheel 3, the second section 2 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 2 is less than the pressure for deforming the second section 2 out of interference with the vehicular operator's ability to operate the steering wheel 3, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 3 when pressure from the portion of the vehicular operator's body on

the second section 2 is equal to or greater than the pressure for deforming the second section 2 out of interference with the vehicular operator's ability to operate the steering wheel 3.

Regarding claim 15, the steering wheel 3 includes a steering wheel 3 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Regarding claim 16, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 17, the first section 4 extends a length of a predetermined peripheral portion of the steering wheel 3.

Regarding claim 19/17, the first section 4 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See "flexibility" in *Fredman v. Harris-Hub Co., Inc., supra*.

Regarding claim 24/14, each first section 4 is formed integral with the steering wheel 3. It is well settled that the term "integral" is not restricted to a one-piece article. The term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326 (CCPA); *In re Clark*, 102 USPQ 241 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Kohno*, 157 USPQ 275 (CCPA); and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Regarding claim 27, the first section 4 is flexible, rigid, or semi-rigid, or non-deformable. See "flexibility" in *Fredman v. Harris-Hub Co., Inc., supra*.

10. Claims 14-17, 19/17, 24/14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Anson (US Patent No. 2,134,020).

Regarding claim 14, Anson teaches a fatigue relieving/preventing apparatus associated with a steering wheel 10 for controlling a vehicle, comprising:

a first section 13 that connects to a peripheral portion of the steering wheel 10; and
a rigid, semi-rigid or flexible, or non-deformable second section 11 that connects to, and extends from the first section 13 at the peripheral portion of the steering wheel 10, the second section 11 extends from the first section 13 outward at an angle (see angle α in Fig. 8 of Attachment 2) to a plane (Att. 2) across a front face of the steering wheel 10, the second section 11 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 11 is less than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 10 when pressure from the portion of the vehicular operator's body on the second section 11 is equal to or greater than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10.

Regarding claim 15, the steering wheel 10 includes a steering wheel 10 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Regarding claim 16, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 17, the first section 13 extends a length of a predetermined peripheral portion of the steering wheel 10.

Regarding claim 19/17, the first section 13 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See “flexible” in *Fredman v. Harris-Hub Co., Inc., supra.*

Regarding claim 24/14, each first section 13 is formed integral with the steering wheel
10. See *In re Hotte; In re Clark; In re Dike; In re Kohno; and In re Morris, supra.*

Regarding claim 27, the first section 13 is flexible, rigid, or semi-rigid, or nondeformable. See “flexible” in *Fredman v. Harris-Hub Co., Inc., supra.*

11. Claims 14, 18, and 19/18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Laubach (US Patent No. 1,575,848).

Regarding claim 14, Laubach teaches a fatigue relieving/preventing apparatus associated with a steering wheel 1 for controlling a vehicle, comprising:

a first section 7, 8 that connects to a peripheral portion of the steering wheel 1; and a rigid, semi-rigid or flexible, or non-deformable second section 10 that connects to, and extends from the first section 7, 8 at the peripheral portion of the steering wheel 1, the second section 10 extends from the first section 7, 8 outward at an angle (see angle α in Fig. 2 of Attachment 3) to a plane (Att. 3) across a front face (Att. 3) of the steering wheel 1, the second section 10 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 10 is less than the pressure for deforming the second section 10 out of interference with the vehicular operator's ability to operate the steering wheel 1, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 1 when pressure from the portion of the vehicular operator's

Art Unit: 3682

body on the second section 10 is equal to or greater than the pressure for deforming the second section 10 out of interference with the vehicular operator's ability to operate the steering wheel 1.

Regarding claim 18, the second section 10 includes at least two second sections (Fig. 1) that each connect to the first section 7, 8 at separate locations.

Regarding claim 19/18, the first section 7, 8 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See "flexible" in *Fredman v. Harris-Hub Co., Inc., supra*.

12. Claims 14-19, 24/14, and 27, as best understood, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28 of copending Application No. 10720821 (Appl.'821). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14-19, 24/14, and 27 of this application and claims 20-28 of Appl.'821 substantially claim common structures such as a first section and a second section connected to the first section. To the extent that claims 14-19, 24/14, and 27 in this application call for the second section being rigid, semi-rigid or flexible, or *non-deformable*, meanwhile, claims 20-28 in Appl.'821 call for the second section being *deformable*, however, the terms rigid, semi-rigid, flexible, non-deformable, and deformable are relative terms. In fact, when the second section is rigid, semi-rigid, or flexible, it will be deformed if enough pressure is applied to it. Alternatively, when the second section is deformable, it inherently is flexible. See *Fredman v. Harris-Hub Co., Inc., supra*. On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in claims 14-19, 24/14, and 27 of this application such that it is deformable as claimed in claims 20-28 of Appl. '821 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin, supra.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Applicant's arguments filed November 3, 2005 and January 30, 2006 have been fully considered but they are not persuasive.

35 USC 112, 2nd Paragraph

Applicant contended that:

New claims 14-28, like cancelled claims 1-13, include the terms "rigid," "semi-rigid," "flexible," and "non-deformable." Applicant has attached as Attachment A excerpts from the *Ninth New Collegiate Dictionary*. These excerpts demonstrate that each of the terms that the Examiner has contended is indefinite is a very common term that a person of ordinary skill in the art would understand with sufficiency to make and use the present invention. The attached excerpts make plain that a person of ordinary skill in the art would *clearly* understand the scope of the claims when "rigid," "semi-rigid," or "flexible," or "non-deformable," is used. As such, claims 14-28 would be definite in the hands of a person of ordinary skill in the art. (Emphasis added).

The Examiner respectfully submits that Applicant is not confined to normal dictionary meaning. *Fromson v. Advance Offset Plate, Inc.*, 219 USPQ 1137, 1140 (Fed. Cir. 1983). It is well established that dictionary definitions must give way to the meaning imparted by the specification. *In re Johnston*, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) cited *Phillips v. AWH Industries*, 415 F.3d 1303 [75 USPQ2d 1321](Fed. Cir. 2005)(*en banc*). In the instant case, the

specification does not impart or define the meaning of the relative terms, such as, rigid, semi-rigid, flexible, and non-deformable. Assuming *arguendo* that a person of ordinary skill in the art would clearly understand the meaning of these terms as defined by dictionary, however, the scope of the claims is still deemed to be indefinite since it is unclear as to, e.g., what materials are covered by the claims. Hence, the rejection under 35 USC 112 is respectfully maintained.

35 USC 102

The rejection based on Lin, Dickinson, or Hamasaka is withdrawn in view of Applicant's amendment in the claims. Applicant's arguments regarding Lin, Dickinson, or Hamasaka are deemed to be moot.

Obviousness Type Double Patenting

Applicant has not filed the terminal disclaimer. Therefore, the rejection based on obviousness type double patenting has not been overcome.

New Prior Art

Applicant argued:

Of the five patents, Laubach, Anson, Van Arsdel, and Berzer, among other things, disclose an element that engages the hand of the driver that is disposed outward or inward from the steering wheel rim in the plane across of the face of the steering wheel. As set forth in claims 14-28, *the second section of the fatigue-relieving apparatus is disposed outward at an angle to the plane across the face of the steering*. This distinguishes claims 14-28 from each of these references. (Emphasis added).

The instant Office action only uses Laubach, Anson, and Van Arsdel. Each of these references teaches the second section disposed outward at an angle to the plane across the face of the steering wheel as seen in Attachments 1-3. Therefore, the elected claims 14-19, 24/14 and 27

are not allowable. The remaining references Shipley and Berzer are not used to reject Applicant's claims. Applicant's arguments about Shipley and Berzer are moot.

Conclusion

For the reasons set forth above, Applicant's request to allow the claims is respectfully denied.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

March 28, 2006



Vinh T. Luong
Primary Examiner

Application/Control Number: 10/727,306
Art Unit: 3682

Page 13

ATTACHMENT # 1

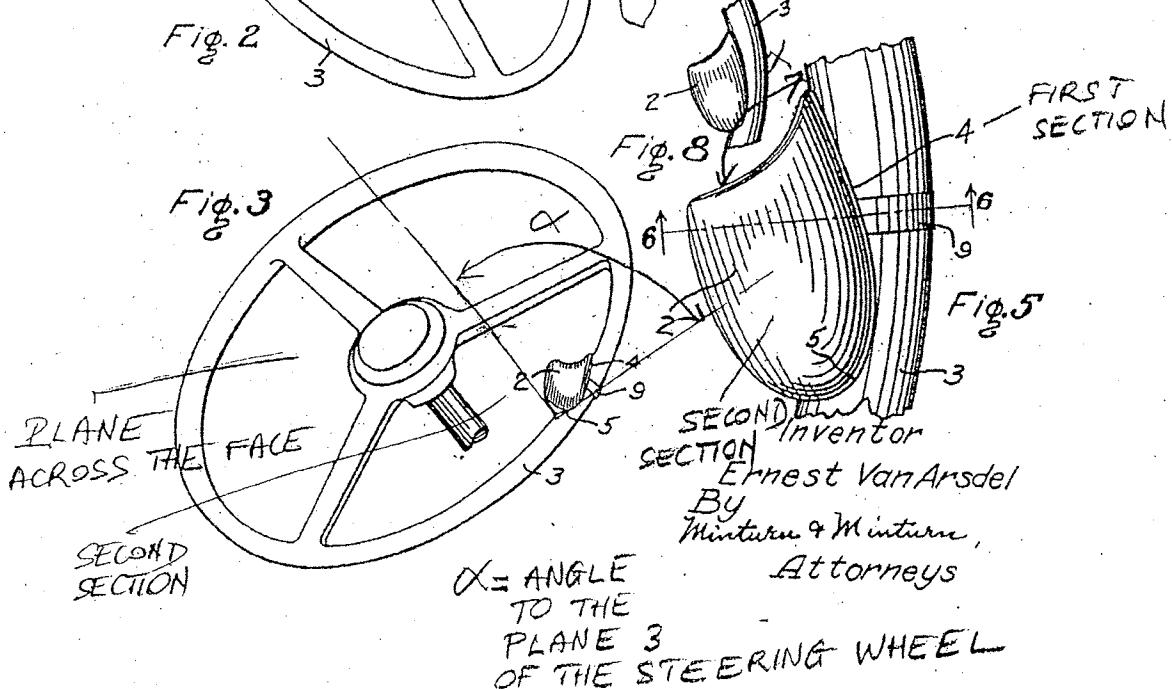
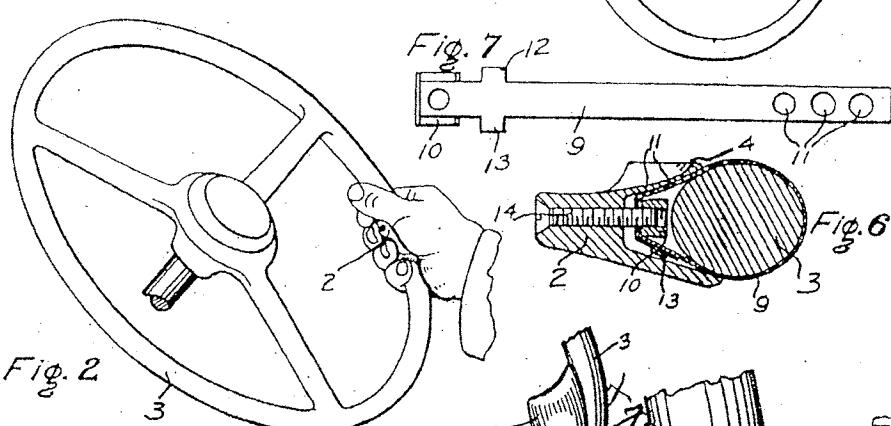
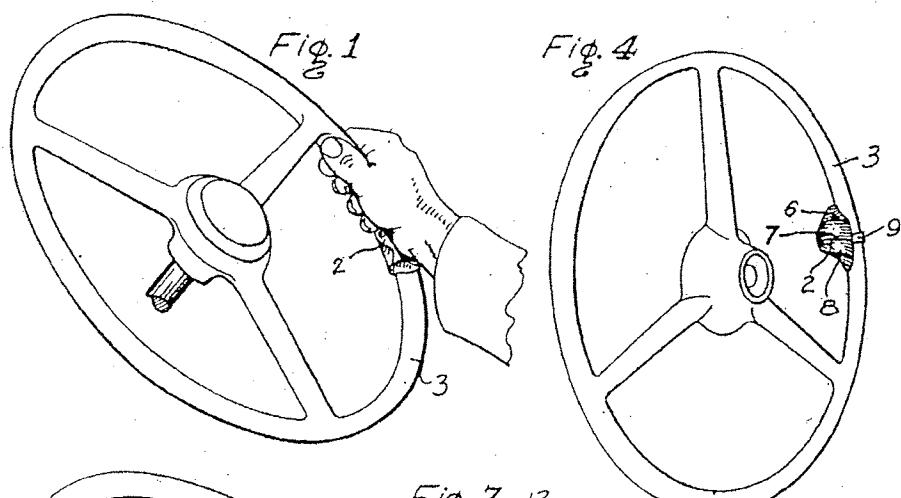
May 24, 1938.

E. VAN ARSDEL

2,118,540

AUTO STEERING WHEEL HANDGRIP

Filed May 10, 1937



Application/Control Number: 10/727,306
Art Unit: 3682

Page 13

ATTACHMENT # 2

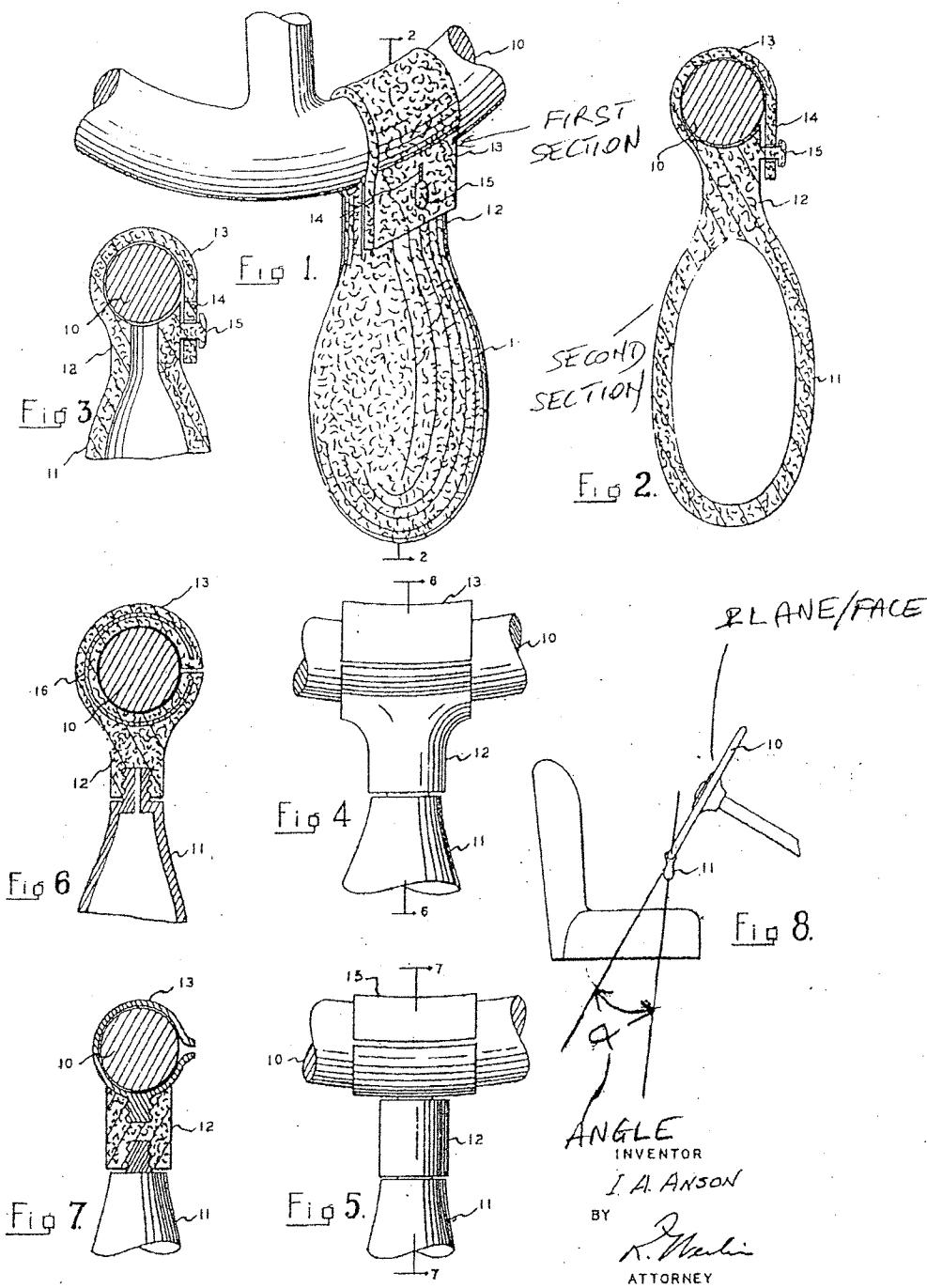
Oct. 25, 1938.

L. A. ANSON

2,134,020

STEERING WHEEL ATTACHMENT

Filed Sept. 30, 1937



Application/Control Number: 10/727,306
Art Unit: 3682

Page 13

ATTACHMENT # 3

March 9, 1926.

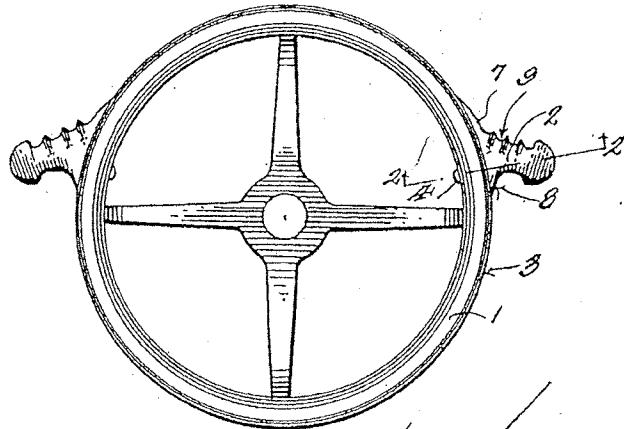
1,575,848

C. E. E. LAUBACH

STEERING WHEEL

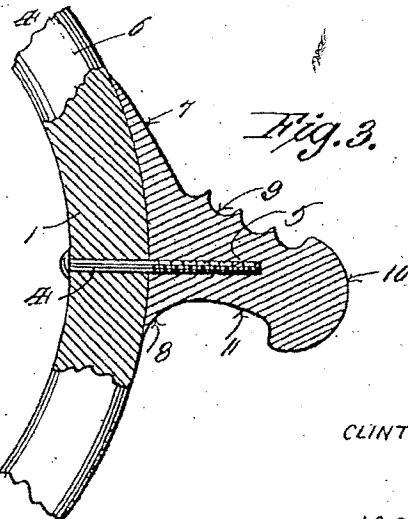
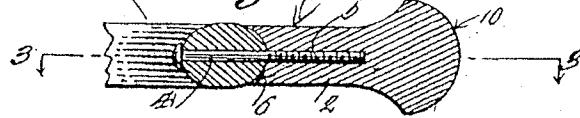
Filed July 13, 1925

Fig. 1.



PLANE/FACE

Fig. 2.



WITNESSES
Guy M. Spring
CLINTON E. LAUBACH Inventor

Richard D. Oliver Attorney